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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,687	02/25/2004	Mark A. Voves	P06555US1	3013
34082	7590	09/14/2005	EXAMINER	
ZARLEY LAW FIRM P.L.C. CAPITAL SQUARE 400 LOCUST, SUITE 200 DES MOINES, IA 50309-2350			PRONE, JASON D	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/786,687

Applicant(s)

VOVES, MARK A.

Examiner

Jason Prone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-7 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1 and 4-7 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 03 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: Appendix A

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Le Grand (1,196,252) in view of Wang (6,305,249) (see Appendix A on page 7 of this Office action for examiner added reference numerals in Figure 1 of Wang).

In regards to claim 1, Le Grand discloses the invention including an elongate body (10) having a forward end with an enclosed first compartment having a shape to receive and engage the shank of a punch (12), a plunger slidably mounted in the body (18) and having a forward end in the enclosed compartment (17), a spring associated with the plunger disposed within a second compartment and yieldingly urging the plunger into the enclosed first compartment (19), an elongated slot in the body (11), and a handle secured to the plunger and extending outwardly through the slot to permit manual grasping thereof to pull the plunger rearwardly against the spring (19').

However, Le Grand fails to disclose a third storage compartment within the body, the second compartment is defined by first and second transverse walls, the first transverse wall separates the first and second compartments and the second transverse wall separates the second and third compartments, and the enclosed first compartment is frusto-shaped having a flat head and tapered side walls. Wang teaches

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a third storage compartment within a body (27), the second compartment is defined by first (1000 see Appendix A) and second transverse walls (1001 see Appendix A), the first transverse wall (1000) separates the first and second compartments (22 and 25) and the second transverse wall (1001) separates the second and third compartments (25 and 27), and the enclosed first compartment is frusto-shaped having a flat head and tapered side walls (24). Therefore, it would have been obvious to one of ordinary skill in the art, to have provided Le Grand with a third storage compartment, transverse side walls, and a frusto-shaped enclosed first compartment, as taught by Wang, for added convenience so the user can have all the necessary tools at his/her disposal and not interfere with the components of the apparatus, to prevent the plunger and spring from moving side-to-side, and to allow the tool to conform to the old and well known shape of most shanks.

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Le Grand in view of Wang as applied to claim 1 above, and further in view of Wyler et al.

(3,933,148). Le Grand in view of Wang disclose the invention but fail to disclose a threaded plug that engages the spring to adjust the compression of the spring. Wyler et al. teaches that it is old and well known to adjust the compression of a spring with a threaded plug (5). Therefore, it would have been obvious to one of ordinary skill in the art, to have provided Le Grand in view of Wang with a threaded plug that engages the spring to adjust the compression, as taught by Wyler et al., to allow the spring to apply a stronger force to the object the spring is biasing.

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4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Le Grand in view of Wyler et al. Le Grand discloses the invention including an elongate body (10) having a forward end with an enclosed first compartment having a shape to receive and engage the shank of a punch (12), a plunger slidably mounted in the body (18) and having a forward end in the enclosed compartment (17), a spring associated with the plunger disposed within a second compartment and yieldingly urging the plunger into the enclosed first compartment (19), an elongated slot in the body (11), and a handle secured to the plunger and extending outwardly through the slot to permit manual grasping thereof to pull the plunger rearwardly against the spring (19').

However, Le Grand fails to disclose a threaded plug that engages the spring to adjust the compression of the spring. Wyler et al. teaches that it is old and well known to adjust the compression of a spring with a threaded plug (5). Therefore, it would have been obvious to one of ordinary skill in the art, to have provided Le Grand in view of Wang with a threaded plug that engages the spring to adjust the compression, as taught by Wyler et al., to allow the spring to apply a stronger force to the object the spring is biasing.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Le Grand in view of Wyler et al. as applied to claim 5 above, and further in view of Wang. Le Grand in view of Wyler et al. disclose the invention but fail to disclose a third storage compartment within the body. Wang teaches a third storage compartment within a body (27). Therefore, it would have been obvious to one of ordinary skill in the art, to have provided Le Grand in view of Wyler et al. with a third storage compartment, as taught by

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Wang, to provide added convenience so the user can have all the necessary tools at his/her disposal and not interfere with the components of the apparatus.

Response to Arguments

6. Applicant's arguments with respect to claims 1, 4 and 7 have been considered but are moot in view of the new ground(s) of rejection.

7. In response to applicant's argument that Wyler et al. is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the apparatus disclosed by Wyler et al. uses a tool that is supported by a spring. The tensioning and un-tensioning of the spring allows the tool to perform specific functions. In *Le Grand* a tool/plunger is also supported by a spring. It is old and well known in the art of springs that more tension to the spring will allow for a greater spring force. Regardless of the intended use of Wyler et al.'s apparatus, Wyler et al. clearly teaches that, in the art of spring tensioned tools, it is old and well known to change the compression/tension of the spring with a threaded plug.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is (571) 272-4513. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 07, 2005

A handwritten signature in black ink, appearing to read "Jason Prone", written in a cursive style.

Patent Examiner
Jason Prone
Art Unit 3724
T.C. 3700

Appendix A

